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APR 22 2008

DOCKET No. 2003.10.010.NS0
U.S. SERIAL NO. 10/810,302
PATENTREMARKS

Claims 1-24 were originally filed in the present application.

Claims 1-24 are pending in the present application.

Claims 1-24 were rejected in the February 22, 2008 Office Action.

No claims have been allowed.

Claims 1, 4-5, 9, 14-15, 20 and 22-23 are amended herein.

Claims 1-24 remain in the present application.

Reconsideration of the claims is respectfully requested.

Applicant notes that amendments to the Claims included herein do not add any new matter.

Accordingly, Applicant respectfully requests that these amendments be entered.

I. REJECTION UNDER 35 U.S.C. § 103

The Examiner rejected Claims 1-18 and 20-24 under 35 U.S.C. §103(a) as being unpatentable over *Zhang* (SIP-based VoIP network and its interworking with the PSTN, Electronics & Communication Engineering Journal, Dec. 2002) ("*Zhang*") in view of U. S. Patent No. 7,197,029 to *Osterhout, et al.* ("*Osterhout*") and Claim 19 under 35 U.S.C. §103(a) as being unpatentable *Zhang* in view of U. S. Patent Application Publication No. 2002/0114317 to *Dorenbosch, et al.* ("*Dorenbosch*"). Of these, Claims 1, 9 and 20 are independent. These rejections are respectfully traversed for the reasons discussed below.

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In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).) The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984).) Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of non-obviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993).) If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).)

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must not be based on the Applicant's disclosure. (*MPEP* § 2142).

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In order to establish obviousness by combining references there must be some teaching or suggestion in the prior art to combine the references. (*Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 U.S.P.Q.2d 1294, 1297 (Fed. Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the references."); *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.").)

Evidence of a motivation to combine prior art references must be clear and particular if the trap of "hindsight" is to be avoided. (*In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be "clear and particular." "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'"); *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998) ("[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'").)

The Applicant respectfully submits that neither *Zhang* nor *Osterhout*, either alone or in combination, discloses, teaches or suggests "a test controller configured to receive a test call initiation message directed to the test controller from an originating terminal, to prompt the

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telecommunication device to allocate one of the voice paths within the telecommunication device for a test call based on the test call initiation message, and to establish a call connection for the test call between the originating terminal and a destination terminal via the allocated voice path and a packet-switched network to test the allocated voice path,” as recited by independent Claim 1, as amended.

To show some aspects of the claimed test controller and originating terminal, the Examiner cites *Zhang*’s SIP server and SIP client, respectively, as shown in Figure 8. Office Action, page 5. The Examiner asserts that the SIP server is configured to receive a test call from the SIP client and to establish a call connection for a test call between Dan and Shirley. Office Action, pages 5-6. However, *Zhang* simply describes the SIP protocol stack, the main features of SIP, and the architecture, messaging and operation of SIP. *Zhang*, Abstract. There is no mention in *Zhang* of a system for testing a voice path of a telecommunication device.

Furthermore, the Examiner admits that “*Zhang* does not explicitly disclose a test controller to prompt the telecommunication device to allocate one of the voice paths within the telecommunication device for the test call and establish a call connection via the allocated voice path and a packet-switched network to test the allocated voice path.” Office Action, page 6. Thus, to show these aspects of the claimed test controller and originating terminal, the Examiner cites the abstract of *Osterhout*. *Id.* The Examiner asserts, using *Osterhout*’s abstract, that the host computer shows the test controller, a SIP device shows the originating terminal, and “testing line conditions for noise and delay” shows testing the allocated voice path. *Id.* However, *Osterhout* describes a system for testing line conditions prior to placing a call. As described in *Osterhout*,

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upon activation of the control module 126 in preparation for a telephone call, the control module may probe the communications link 112 and other information to determine if the criteria for making a SIP-initiated network-based call are met, at the time of placing the call. If the criteria are met, the control module 126 may set up the remainder of the resources necessary to establish a SIP-based connection to a recipient telephone device 120... For instance, the SIP module 122 may transmit a Call Invite command to the recipient telephone device 120... Once the call setup is achieved via SIP messaging, a voice or other path... may be established between the USB telephone 102 and the recipient telephone device 120.

Osterhout, col. 4, lines 60-67 and col. 5, lines 7-14 (emphasis added).

Thus, the testing described in *Osterhout* is performed prior to the establishment of the voice path. In contrast, the claimed test controller is configured to establish a call connection for the test call between the originating terminal and a destination terminal to test the allocated voice path. Thus, the claimed test controller first establishes the call connection in order to test the allocated voice path, while *Osterhout*'s system first tests the communications link in order to determine whether or not to establish a voice path.

In addition, as amended, the claimed test controller is configured to receive a test call initiation message directed to the test controller from an originating terminal. Thus, the originating terminal sends a test call initiation message directed to the test controller, not directed to the destination terminal. This message initiates the testing procedure because the test controller prompts the telecommunication device to allocate one of the voice paths within the telecommunication device for a test call based on the test call initiation message. In contrast, *Osterhout*'s system describes a USB telephone placing a call that is directed to the recipient telephone device, not directed to the host computer. Modifying *Osterhout* to include this feature would add cost without providing any

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benefit because the USB telephone is "connected to a host computer 106 via USB connection 104." *Osterhout*, col. 2, lines 48-49. Thus, there is no reason to modify *Osterhout* to allow the USB telephone to place a call directed to the host computer as these two devices are already able to communicate directly over the USB connection. Therefore, for at least these reasons, a *prima facie* case of obviousness against independent Claim 1, as amended, has not been presented with reference to the cited art, either alone or in combination. Therefore, the Applicant respectfully submits that this rejection should now be withdrawn.

Similar to independent Claim 1, independent Claim 9, as amended, recites "an originating terminal configured to generate a test call initiation message; and a test controller configured to receive the test call initiation message from the originating terminal, the test call initiation message being directed to the test controller, to prompt the telecommunication device to allocate one of the voice paths within the telecommunication device for a test call based on the test call initiation message, and to establish a call connection for the test call between the originating terminal and a destination terminal via the allocated voice path and a packet-switched network to test the allocated voice path," and independent Claim 20, as amended, recites "receiving a test call initiation message directed to a test controller from an originating terminal; sending a signaling message to the telecommunication device to allocate one of the voice paths for a test call in the telecommunication device based on the test call initiation message; establishing a connection between the originating terminal and a destination terminal for the test call through a packet-switched network using the allocated voice path; and testing the allocated voice path during the test call." Accordingly, for the

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reasons discussed above in connection with Claim 1, independent Claims 9 and 20 are not made obvious by the cited art. Therefore, the Applicant respectfully submits that these rejections should now be withdrawn.

Dependent Claims 2-8, which depend from independent Claim 1, dependent Claims 10-19, which depend from independent Claim 9, and dependent Claims 21-24, which depend from independent Claim 20, are also not made obvious by the cited art because they include the limitations of their respective base claims and add additional elements that further distinguish the art. Therefore, the Applicant respectfully submits that these rejections should now be withdrawn.

The Applicant also disagrees with the Examiner's rejections of Claims 1-24 based on additional misdescriptions and/or misapplications of *Zhang*, *Osterhout* and *Dorenbosch* to at least some of Claims 1-24. However, the Applicant's arguments regarding those other shortcomings of *Zhang*, *Osterhout* and *Dorenbosch* are moot in view of the Claim 1 arguments above. However, the Applicant reserves the right to dispute in future Office Action responses the appropriateness and the applications of *Zhang*, *Osterhout* and *Dorenbosch* to the claims of the present application, including the right to dispute assertions made by the Examiner in the February 22, 2008 Office Action.

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SUMMARY

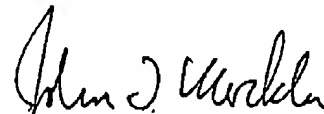
For the reasons given above, the Applicants respectfully request reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: April 22, 2008



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